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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,026	06/25/2001	Philip A. Carpino	PC10861ABTC	9458

7590

04/04/2002

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EXAMINER

DENTZ, BERNARD I

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 04/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/891,026

Applicant(s)

CARPINO ET AL.

Examiner

Bernard Dentz

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 17-28 is/are rejected.
- 7) ☒ Claim(s) 11-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) *∞ 1 reference.*
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-28, drawn to compounds, compositions and methods of use where D is cyclic value (the tetrahydroquinoline including structural formula) classified in class 546, subclass 120 e.g..
- II. Claims 1 and 17-28, drawn to compounds, compositions and methods of use where D is the other values, classified in class 544, subclass 236 e.g.

The inventions are distinct, each from the other because:

The instant claims include a vast scope of compounds of different structure.

Because of the above reasons and because the searches are different restriction as above is proper.

During a telephone conversation with Mr. Creagan on 3-28-2002 a provisional election was made with traverse to prosecute the invention of GP. I, claims 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 and 17-28, the non-elected parts only have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-10 and 17-28 are rejected as unpatentable under 35 U.S.C. 102 as being anticipated by Bakshi et al, WO 01/91752 which has a priority date of May 30, 2000 based on U.S. Provisional application 60/207,918.

It discloses and teaches how to make a genus of melanocortin receptor agonists, which overlap the instant genus of compounds. This occurs when instantly HET is the third structural formula and D is the elected cyclic structure. See the first 2 values of Z and the first value of Q in the reference.

The species in the reference at p. 20, lines 8-12 (also Ex. 3) is the same as the first species of instant claim 9.

Claims 1 and 17-28 are rejected for misjoinder of invention for the above reasons.


Claims 11-16 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Dentz whose telephone number is 308-4544. The examiner can normally be reached on Monday-Friday 8 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Rotman can be reached on 308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3592 for regular communications and 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Dentz:mv  
April 1, 2002

  
BERNARD DENTZ  
PRIMARY EXAMINER  
GROUP 1625